

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LORI GREINER

Appeal 2007-3504
Application 09/824,937
Technology Center 3700

Decided: December 13, 2007

Before DONALD E. ADAMS, ERIC B. GRIMES, and LORA M. GREEN,
Administrative Patent Judges.

GREEN, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 15-18, 21-23, and 26.¹ We have

¹ Claims 19, 24, and 25 are also pending but are not rejected in the Examiner's Answer. Since the Yellin reference previously relied on to reject these claims is not cited in the Answer, we understand the rejections of claims 19, 24, and 25 to have been withdrawn.

jurisdiction under 35 U.S.C. § 6(b). Claim 15 is representative of the claims on appeal, and reads as follows:

15. A decorative container system for displaying items in a hollow region comprising:

a decorative container comprising an upper opening and an inner container positioned within an outer container thereby defining the hollow region therebetween, wherein the outer container is at least partially transparent;

a removable hollow region access member allowing access to the hollow region; and

a decorative lid shaped to be removably mounted in the upper opening of the decorative container, the decorative lid defining a hollow lid cavity and being at least partially transparent, the lid further comprising a removable lid access member providing access to the hollow lid cavity, wherein the removable lid access member is replaceable in the decorative lid.

The Examiner relies upon the following references:

Tupper	US 2,802,590	Aug. 13, 1957
Gallegos	US 5,275,277	Jan. 4, 1994
Kimura	US 5,553,735	Sept. 10, 1996
Barnes	US 5,674,546	Oct. 7, 1997

We affirm.

DISCUSSION

Claims 15-18, 21-23, and 26 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Kimura, Barnes, and Tupper. As the claims stand or fall together (Br. 7), we focus our analysis on independent claim 15.

Kimura is cited for disclosing “a decorative container displaying items in a hollow region comprising an inner container positioned within an outer

container thereby defining a hollow region there between, the outer container is transparent, a removable member (24) allows access to the hollow region.” (Answer² 3.) According to the Examiner, Kimura teaches all of the limitations of the claimed decorative container except for the decorative lid (*id.*).

Barnes is cited for teaching “a decorative lid removably mounted in the upper opening of a decorative container, the lid defining a hollow cavity and being transparent, the lid comprising a removable access member providing access to the hollow cavity.” (*Id.* at 3-4.)

According to the Examiner, it would have been obvious to add a lid to the decorative container of Kimura in order to close the container and seal the contents from contamination (*id.* at 4). The combination of Kimura and Barnes, the Examiner asserts, teaches all of the limitations of the container except for the lid access member being removable (*id.*).

Tupper is cited for teaching a “lid access member (plate A) which is replaceable and removable by groove 25 which is removably and replaceably engaged upon flange 23 of the lid.” (*Id.* at 5.) The Examiner concludes that it “would have been obvious to add the groove and flange to Barnes’ lid access member and lid, respectively, in order to change the contents and store a refreshed supply of items in the hollow lid cavity.” (*Id.*)

The burden is on the Examiner to set forth a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed

² All references to the Answer are to the Examiner’s Answer mailed April 26, 2006.

invention and the prior art; and (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The Supreme Court has recently emphasized that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739. Moreover, an “[e]xpress suggestion to substitute one equivalent for another need not be present to render such substitution obvious.” *In re Fout*, 675 F.2d 297, 301 (CCPA 1982). We conclude that the Examiner has set forth a prima facie case of obviousness, and the rejection is affirmed.

Appellant argues that there is no motivation to combine the references to provide a lid with a cavity (Br. 11). Appellant asserts that while “it is not uncommon for drinking vessels to be provided with lids, the Examiner has not presented any motivation for adding an upper container having a cavity to a drinking vessel.” (*Id.*) The cavity of Barnes is to hold the omelet inlay ingredients, and, Appellant argues, the Examiner has not pointed to any motivation in the prior art to modify the drinking vessel of Kimura to add an upper container with a cavity (*id.*) Tupper does not remedy the deficiency, Appellant asserts, as there is no reason to add a deodorizing element as provided in the waste can of Tupper (*id.*).

Appellant argues further that there is no motivation to combine the references to provide a lid with a replaceable lid access member (*id.* at 12).

According to Appellant, “because Barnes is a one-time use omelet cooker, there would be no reason to modify it so that the lid is replaceable.” (*Id.*)

With respect to motivation to combine references, the Supreme Court in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), rejected a rigid application of the teaching-suggestion-motivation test. The Court recognized that it is often necessary to look at the interrelated teaches of multiple references; the effects of demands of the marketplace; and the background knowledge possessed by a person of ordinary skill, “all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed.” *Id.* at 1740-41. Moreover, the “obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, or motivation, or by overemphasis on then importance of published articles and explicit content of issued patents.” *Id.* at 1741. As noted by the Court in *KSR*, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” 127 S.Ct. at 1742.

Kimura teaches a vessel with a display area, in which three-dimensional objects, such as liquid, powder, mechanical items, or electronics may be used as decorations (col. 1, ll. 30-33). A cavity is formed between an inner shell and an outer shell (col. 1, ll. 39-45). The cavity may be opened and closed by connection or disconnection of the shell by simple widely used mechanical methods such as screw, hinge, insertion, etc. (col. 1, ll. 53-58). According to Kimura, if the decoration or information may be changed, the vessel will less likely be disposed of, contributing to the conservation of natural resources (col. 1, ll. 33-38).

Barnes teaches a package for storing or cooking an omelet, in which a transparent lid holds an omelet inlay (i.e., filling) (Barnes, Figure 2).

Thus, we agree with the Examiner that it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a decorative lid as taught by Barnes to the container of Kimura in order to obtain a beverage container with a lid. Using a decorative lid that defines a hollow lid cavity and being at least partially transparent, the lid further comprising a removable lid access member providing access to the hollow lid cavity, wherein the removable lid access member is replaceable in the decorative lid, would have also been obvious in view of the teaching of Kimura that the container provides a cavity to allow for decorations or information to be changed, and in view of Barnes' disclosure that such lids are known in the art. As to the access member, it would have been obvious to use any of the mechanical means taught by Kimura, such as a screw, hinge, or insertion, to allow the contents of the lid to be changed. Thus, the combination of Kimura and Barnes teaches all of the elements of claim 15. Tupper provides evidence that it was well within the level of skill of the ordinary artisan to provide a lid access member which is replaceable and removable by groove that is removably and replaceably engaged upon a flange of the lid.

Appellant argues that Barnes and Tupper are non-analogous art, and thus not properly combinable with Kimura (Br. 10). Kimura, Appellant asserts, is drawn to a reusable drinking glass, Barnes describes a one-time use omelet cooking container, while Tupper is drawn to a waste can with a means of deodorizing the odors present in the waste can (*id.* at 10-11). Appellant asserts that "Tupper's deodorized waste can and Barnes' onetime use omelet cooker are so different and serve such different purposes that one

of ordinary skill in the art would not seek to combine these references.” (*Id.* at 11).

If a reference is reasonably analogous to the problem being addressed by the inventor, the prior art is not non-analogous. *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1379-80 (Fed. Cir. 2007). As noted by the Supreme Court,

If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill would recognize that it would improve similar devices in the same way, using the technique is obvious unless its application is beyond his or her skill.

KSR, 127 S. Ct. at 1740. In other words, “familiar items may have obvious uses beyond their primary purposes.” *Id.* at 1742.

Thus, we find that Kimura, Barnes, and Tupper are not non-analogous. Each deals with a container or vessel, and as acknowledged by Appellant (Br. 11), it is not uncommon for a drinking vessel to be provided with a lid.

Claims 15-18, 21, 22, and 26 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Gallegos, Barnes, and Tupper. As the claims stand or fall together (Br. 7), we focus our analysis on independent claim 15.

Gallegos is cited for disclosing a “decorative container displaying items in a hollow region comprising an inner container positioned within an outer container thereby defining a hollow region therebetween, the outer container is transparent, a removable member (24) allows access to the hollow region.” (Answer 4.) According to the Examiner, Gallegos teaches

all of the limitations of the claimed decorative container except for the decorative lid (*id.*).

Barnes is cited for teaching “a decorative lid removably mounted in the upper opening of a decorative container, the lid defining a hollow cavity and being transparent, the lid comprising a removable access member providing access to the hollow cavity.” (*Id.* at 4-5.)

According to the Examiner, it would have been obvious to add a lid to the decorative container of Kimura in order to close the container and seal the contents from contamination (*id.* at 4). The combination of Gallegos and Barnes, the Examiner asserts, teaches all of the limitations of the container except for the lid access member being removable (*id.*).

Tupper is cited for teaching a “lid access member (plate A) which is replaceable and removable by groove 25 which is removably and replaceably engaged upon flange 23 of the lid.” (*Id.* at 5.) The Examiner concludes that it “would have been obvious to add the groove and flange to Barnes’ lid access member and lid, respectively, in order to change the contents and store a refreshed supply of items in the hollow lid cavity.” (*Id.*)

Appellant essentially reiterates the arguments with respect to the rejection over the combination of Kimura, Barnes, and Tupper (Br. 12-15). Thus, this rejection is also affirmed for the reasons set forth above.

CONCLUSION

Because we conclude that the Examiner has set forth a *prima facie* case of obviousness, the rejections on Appeal are affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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